Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIYOTAKA MURAI and KENJI TAKAHASHI

Appeal No. 1998-1533
Application No. 08/411,202[1]

HEARD: October 19, 1999

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 to 3, 5 and 6, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

We AFFIRM-IN-PART and enter a new rejection pursuant to 37 CFR § 1.196(b).

[1] Application for patent filed March 27, 1995.

BACKGROUND

The appellants' invention relates to a disc brake assembly. An understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the opinion section below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kawase	4,471,858	Sep. 18, 1984
Feldmann et al. (Feldmann)	4,600,090	July 15, 1986
Tarter	4,705,146	Nov. 10, 1987
Iwashita et al. (Iwashita)	5,363,943	Nov. 15, 1994[2]
Hummel et al. (Hummel)	5,535,860	July 16, 1996[3]

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tarter in view of Feldmann.

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[2] Filed October 8, 1992.

[3] Effective filing date March 23, 1994.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tarter in view of Feldmann and further in view of Kawase.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tarter in view of Feldmann and further in view of Iwashita.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hummel in view of Feldmann.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hummel in view of Feldmann and further in view of Iwashita.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 10, mailed October 8, 1996) and the answer (Paper No. 16, mailed July 8, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15,

filed March 26, 1997) and reply brief (Paper No. 17, filed September 5, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is obvious must

be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the rejections of the claims on appeal made by the examiner.

Claims 1 to 3

We will not sustain the rejection of claims 1 to 3 under 35 U.S.C. § 103.

Independent claim 1 reads as follows:

> A disc brake assembly having a pair of brake shoes each with a friction pad member to be pressed into contact with a disc rotor having a circumferential length secured for rotation with a road wheel of an automotive vehicle, wherein upon contact with the brake shoes, the disc rotor oscillates at a three-nodes diametric mode,
>
> wherein each friction pad member of said brake shoes has an upper portion with a total width determined to be less than substantially 1/12 of the circumferential length of said disc rotor at a position where said rotor is brought into frictional engagement with the upper portion of said friction pad member so that the friction pad member reduces oscillation frequencies of said disc rotor so that occurrence and level of brake noises noticeably decrease.

Tarter's invention relates to a disc brake having first and second pads whose surface area that engages a rotor has an arcuate length that is less than that which would excite certain nodes of vibration of the rotor to substantially eliminate the creation of undesirable noise. As shown in Figures 1 and 2, a disc brake 10 includes a rotor 12 with a hub 14 that is carried on bearings 16 and 18 on shaft or axle 20. A generally C-shaped caliper 28 surrounds rotor 12 and is secured to support 26 by an anchor plate 27. Caliper 28 has a front or outboard leg 30 and a rear or inboard leg 32 interconnected by a bridge portion 34. The inboard caliper

leg 32 contains a hydraulic actuation piston 36 which is located in bore 38 connected to a source of operational fluid. Piston 36 engages backing plate 40 of the inboard friction pad 42. An indirectly actuated outboard friction pad 44 has its backing plate 46 connected to outboard leg 30. When hydraulic fluid is supplied to bore 38 through inlet port 48, piston 36 moves inboard pad 42 into engagement with face 50 on rotor 12 whereupon caliper 28 slides on pins to move backing plate 46 toward rotor 12 causing outboard pad 44 to engage face 52 on rotor 12. Figure 3 is a table illustrating the measured natural frequency of the rotor of the disc brake of Figure 1.

Tarter teaches that Figure 4 shows the geometrical correlation that exists between the footprint 80 of the friction pads 42 and 44, respectively, and the mode shape corresponding to five nodal diameters (a-e) and a natural frequency of 7000 hertz. It can be seen that the footprints 80 of the friction pads 42 and 44 are the same as shown in Figure 4. The footprints subtend an angle equal to that subtended by a whole number of adjacent nodal diameters, in this case, three. Tarter states (column 3, line 59, to column 31) that

[i]n order to determine if this geometrical relationship is indicative of a real physical effect, or is merely fortuitous, a set of friction pads 42' and 44', shown in FIG. 5, which had previously squealed at frequencies of 2 to 15 kHz with a median frequency of 7 kHz were beveled on both sides to reduce the footprint of the pad on the rotor to 50% of its original value. When retested using these pads, the brake squealed at 17 to 18 kHz with a median frequency of 17 kHz. FIG. 6 shows that the footprints of beveled pads 42' and 44'. Footprints 82 subtends an angle subtended by three whole adjacent nodal diameters, for the mode having a total of ten nodal diameters a'-j', corresponding to a natural frequency of 16.5 kHz.

These experimental results indicated correlation exists between the footprint of the friction pads 42 and 44 on the rotor 12 and the axial mode of rotor vibration that is excited by the pads 42 and 44. Exciting an axial mode of rotor vibration can potentially excite any torsional modes of rotor vibration. However, elementary vibration theory shows that a resonant system is more sensitive to vibration that is less than its natural frequency rather than greater than its natural frequency. Hence, if a higher frequency axial mode is excited, it becomes less likely that lower frequency torsional modes would be excited. Since the ability of the total human population to hear squeals drops off as the frequency increases, sufficiently high frequencies that produce a brake squeal can be disregarded. Thus brake squeal complaints can be expected to decrease as squeal frequency increases. The above test indicated a beneficial effect on brake squeal by decreasing the friction pad footprint since higher and higher axial modes are excited as it decreases, which in turn decreases the possibility of exciting torsional modes.

There is, however, a serious objection to gross reductions in friction pad area, namely that wear is substantially increased. What is wanted is a method of obtaining the helpful effect of area reduction, while keeping the actual surface area as large as possible.

Lastly, Tarter concludes (column 4, lines 62-68) that

> the smaller the combined footprint of a set of friction pads on a rotor, the higher the rotor axial natural frequency that will be excited by the friction pads. In addition, the higher the axial natural frequency that is excited, the less likely that torsional modes at a lower natural frequency will be created during a brake application.

Feldmann's invention relates to a brake lining support in disc brakes, particularly in fully-lined disc brakes of motor vehicles. As shown in Figures 1-4, the disc brake includes a caliper or actuator 15, a rotor 16, and a brake ring consisting of three brake lining support segments 1, 8, 9. As shown in Figure 2, segment 1 is equipped with four brake linings or pads 2, 3, 4 and 5. Feldmann teaches (column 3, lines 55-56, and claim 11) that each support segment has four discrete linings or pads.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on the examiner's analysis and review of Tarter and claim 1, the examiner ascertained (final rejection, p. 4) that the only difference is the limitation that the total width of the friction pad member is less than substantially 1/12 of the circumferential length of the disc rotor at a position where the rotor is brought into frictional engagement with the upper portion of the friction pad member.

With regard to this difference, the examiner determined (final rejection, p. 4) that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to "have provided the structure of Tarter of for example Fig. 4 with a group of brake shoes spaced in the manner disclosed by Feldman [sic, Feldmann]." Alternatively, the examiner determined (final rejection, p. 4) that it would have been an obvious expedient at the time the invention was made to a person having ordinary skill in the art to

> have provided Tarter Fig 5 with a "footprint" which would be smaller than the ratio 1/12 since the size of the initial footprint would be based on the anticipated wear during the expected useful cycle of the brake.

The examiner further determined (final rejection, pp. 4-5) that it would have been a further obvious expedient at the time the invention was made to a person having ordinary skill in the art to

> have provided Tarter Fig 5 with a "footprint" 80 which would be less than the 1/10 (see the bottom of column 3) since it was known in the art that the "footprint" would increase because of wear in the embodiment of Fig. 5 (see column 4, lines 26-30), and thus with a larger footprint the "squeal" frequency would decrease to one which would be capable of being heard by the human ear (See Tarter Fig. 3).

The appellants argue (brief, pp. 8-9) that the combined teachings of Tarter and Feldmann would not have suggested reducing the total width of Tarter's pad member and that Feldmann's teachings would have suggested increasing the size of Tarter's pad member. Specifically, the appellants contend that claim 1 recites "that each friction pad member has a **total upper width less than substantially 1/12** of the circumferential length of the disc rotor where the rotor is brought into frictional engagement with the friction pad member" and that Tarter and Feldmann would not have suggested this feature.

The examiner (answer, p. 4) responded to this argument by noting that the use of the term "substantially 1/12" in claim 1 results in "broad limits, both below and above 1/12" since "substantially" is considered a broad term.

The appellants responded (reply brief, pp. 2-3) to this position of the examiner by stating that there is "no basis for expanding the meaning of substantially one twelfth to broad limits above and below 1/12" and that the term "*substantially* is used in recognition of the inexactitude of manufacturing, not to impart broad upper and lower limits on the total width."

We agree with the examiner that the only difference between claim 1 and Tarter is the limitation that the total width of the friction pad member is less than substantially 1/12 of the circumferential length of the disc rotor at a position where the rotor is brought into frictional engagement with the upper portion of the friction pad member. However, we agree with the appellants' position set forth in the brief that the combined teachings of Tarter and Feldmann would not

have suggested reducing the total width of Tarter's pad member. In that regard, we fail to find any evidence[4] in the applied prior art that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to reduce the size of Tarter's pad member to meet the above-noted limitation. Additionally, while Feldmann does teach the use of twelve brake pads, we see no reason, absent

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[4] Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

the use of impermissible hindsight[5], a person having ordinary skill in the art would have found it obvious to have provided Tarter with additional braking pads since this would be contrary to the teachings of Tarter.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed.

We have also reviewed the Kawase reference additionally applied in the rejection of claim 2 (dependent on claim 1) and the Iwashita reference applied in the rejection of claim 3 (dependent on claim 1) but find nothing therein which makes up for the deficiencies of Tarter and Feldmann discussed above regarding claim 1. Accordingly, we cannot sustain the examiner's rejection of appealed claims 2 and 3 under 35 U.S.C. § 103.

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[5] The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Claim 5

We sustain the rejection of claim 5 under 35 U.S.C. § 103.

Independent claim 5 reads as follows:

> A disc brake assembly having a pair of brake shoes to be pressed into contact with a disc rotor secured for rotation with a road wheel of an automotive vehicle,
> wherein each of said brake shoes has a friction pad member having an upper portion opposite a lower portion, the upper portion having an upper width less than a lower width of the lower portion, and the upper width in total is less than about 1/12 of a circumferential length of said disc rotor at a position where said disc rotor is brought into frictional engagement with the upper portion of said friction pad member.

Hummel's invention relates generally to brake systems of the type used in domestic road vehicles, and particularly concerns an improved brake friction pad assembly having an elastomeric noise-damping material incorporated into the assembly only after complete material thermal curing. As shown in Figures 1 and 2, the disc brake friction pad assembly 10 comprises a molded friction pad element 12, a thermally cured elastomeric adhesive film 14 adhered to the mating surface of element 12, a metal backing plate element 16 for

mounting the assembly in a cooperating vehicle brake system, and rivet fasteners 18 utilized to mechanically join friction pad element 12 to backing plate element 16 with film 14 being located in an intermediate position. As shown in Figure 1, the friction pad element 12 has an upper portion opposite a lower portion wherein the upper portion has an upper width less than a lower width of the lower portion.

The teachings of Feldmann have been previously set forth above with respect to claim 1.

Based on the examiner's analysis and review of Hummel and claim 5, the examiner ascertained (final rejection, p. 7) that the only difference is the limitation that the upper width in total is less than about 1/12 of a circumferential length of said disc rotor at a position where said disc rotor is brought into frictional engagement with the upper portion of said friction pad member.

With regard to this difference, the examiner determined (final rejection, p. 7) that it would have been obvious at the

time the invention was made to a person having ordinary skill in the art to "have provided the structure of Hummel with a circumference like that of Feldmann, in order to provide a consistent braking effect under rotational circumstances."

The appellants argue (brief, pp. 12-13) that there is simply no suggestion in the applied prior art to have combined the teachings of Hummel and Feldmann to have arrived at the claimed invention. We do not agree.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As stated earlier, it is

impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In this case, it is our opinion that the combined teachings of Hummel and Feldmann would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have provided a disc brake assembly with a brake ring as taught by Feldmann with each of the twelve brake pads thereof made and shaped in the manner taught by Hummel. In our view, the resulting structure from this combination of

the teachings of Hummel and Feldmann does arrive at the claimed invention. In this regard, it is our determination that the broadest reasonable meaning[6] of

> each of said brake shoes has a friction pad member having an upper portion opposite a lower portion, the upper portion having an upper width less than a lower width of the lower portion, and the upper width in total is less than about 1/12 of a circumferential length of said disc rotor at a position where said disc rotor

is that each friction pad member has a total upper width less than about 1/12 of a circumferential length of the disc rotor at a position where the disc rotor is brought into frictional engagement with the upper portion of each friction pad member.

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[6] In proceedings before the Patent and Trademark Office (PTO), the PTO applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

To apply the meaning sought by the appellants[7] would, in our view, be improperly reading limitations from the specification into the claims.[8]

Since the combined teachings of Hummel and Feldmann would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have arrived at the claimed invention for the reasons set forth above, the decision of the examiner to reject claim 5 under 35 U.S.C. § 103 is affirmed.

Claim 6

We will not sustain the rejection of claim 6 under 35 U.S.C. § 103.

Dependent claim 6 reads as follows:

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[7] The appellants argue that the meaning should be that the total width of all the friction pad members is less than about 1/12 of the circumferential length of the disc rotor.

[8] Limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

> A disc brake assembly as recited in claim 5, wherein each of said friction pad members is formed in at least two laterally spaced portions and wherein the upper width and lower width are measured at outside edges of outermost laterally spaced portions.

With respect to claim 6, the examiner ascertained (final rejection, p. 7) that the applied prior art (i.e., Hummel) lacks "a pair of laterally spaced rectangular friction pad members."

With regard to this additional difference, the examiner determined (final rejection, pp. 7-8) that such a difference would have been obvious from the teachings of Iwashita.

The appellants argue (brief, p. 13) that the subject matter of claim 6 is not suggested by the applied prior art. We agree. First, we note that the examiner's ascertainment of the difference between claim 6 and the prior art is incorrect since claim 6 does not recite "a pair of laterally spaced **rectangular** friction pad members." In fact, claim 6 recites that "each of said friction pad members is formed in at least

two laterally spaced portions" while parent claim 5 recites that the friction pad members have an upper portion having an upper width which is less than a lower width of a lower portion. Second, we see no reason, absent the use of impermissible hindsight, a person having ordinary skill in the art would have found it obvious to have further modified the teachings of Hummel and Feldmann as combined together above with respect to claim 5 by forming each friction pad member in at least two laterally spaced portions wherein the upper width in total of each friction pad member is less than about 1/12 of a circumferential length of the disc rotor as set forth in parent claim 5.

For the reasons set forth above, the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 is reversed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Feldmann.

Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Claim 1 is anticipated by Feldmann. We read claim 1 on Feldmann as follows: A disc brake assembly having a pair of brake shoes (two of Feldmann's segments 1, 8, 9) each with a friction pad member (one of Feldmann's pads 2, 3, 4, 5 on each segment) to be pressed into contact with a disc rotor (Feldmann's rotor 16) having a circumferential length secured for rotation with a road wheel of an automotive vehicle, wherein upon contact with the brake shoes, the disc rotor oscillates at a three-nodes diametric mode, wherein each friction pad member of said brake shoes has an upper portion with a total width determined to be less than substantially 1/12 of the circumferential length of said disc rotor at a position where said rotor is brought into frictional engagement with the upper portion of said friction pad member (each of Feldmann's pads 2, 3, 4, 5 on each segment has a total width less than 1/12 of the circumferential length of the rotor at a position where the rotor is brought into frictional engagement with the upper portion of each pad) so that the friction pad member reduces oscillation frequencies of said disc rotor so that occurrence and level of brake noises noticeably decrease.

Similar to our determination set forth above with respect to claim 5, it is our it is our determination that the broadest reasonable meaning of

> each friction pad member of said brake shoes has an upper portion with a total width determined to be less than substantially 1/12 of the circumferential length of said disc rotor at a position where said rotor is brought into frictional engagement with the upper portion of said friction pad member

is that each friction pad member has a total width less than substantially 1/12 of a circumferential length of the disc rotor at a position where the disc rotor is brought into frictional engagement with the upper portion of each friction pad member.

To apply the meaning sought by the appellants[9] would, in our view, be improperly reading limitations from the specification into the claims.

CONCLUSION

[9] The appellants argue that the meaning should be that the total width of all the friction pad members is less than substantially 1/12 of the circumferential length of the disc rotor.

To summarize, the decision of the examiner to reject claim 5 under 35 U.S.C. § 103 is affirmed; the decision of the examiner to reject claims 1 to 3 and 6 under 35 U.S.C. § 103 is reversed; and a new rejection of claim 1 under 35 U.S.C. § 102(b) has been added pursuant to provisions of 37 CFR § 1.196(b)

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

> (b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final

action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN Administrative Patent Judge	)
JOHN P. McQUADE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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APPEAL NO. 1998-1533 - JUDGE NASE
APPLICATION NO. 08/411,202

APJ NASE

APJ McQUADE

APJ COHEN

DECISION: **AFFIRMED-IN-PART**;
37 CFR § 1.196(b)

Prepared By: Gloria Henderson

DRAFT TYPED: 25 Oct 99

FINAL TYPED:

Heard: Oct. 19, 1999